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In re application of :
Stein et al. : DECISION ON
Serial No. 10/604,459 : PETITION
Filed: July 23, 2003 :
For: METHOD AND APPARATUS TO ADAPTIVELY COOL A WELDING-TYPE
SYSTEM

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed July 19, 2005.

On March 24, 2005, a non-final office action was mailed to applicants rejecting all of the claims over various prior art references. Among the rejections was a rejection under 35 USC 102 (b) over French Patent 2,536,320 which was cited by Applicants in an IDS. In the rejection, the examiner referred to a translated abstract, the specification and the figures. Applicants responded to the office action on May 17, 2005. In the response, it was argued that the reliance upon an abstract is improper and it was requested that the examiner provide a translation and rely upon the entire French document in any subsequent rejections. In response, the examiner prepared a final office action repeating the same rejections and provided Applicants with a translation of the French document. Applicants requested the withdrawal of the finality of the office action on August 2, 2005 by way of a telephone message left with the examiner.

On September 22, 2005 the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the July 19, 2005 office action.

Applicants position for the withdrawal of the finality is that no clear issue as been established between the examiner and applicants prior to the final rejection.

DECISION

Section 706.07 of the MPEP states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Petitioner argues that it is not proper to maintain a rejection that was based in whole or in part on a non-English language document and make such an action final.

Throughout the petition, Petitioner refers to Section 2271 of the MPEP. This section is not applicable to the instant situation in that it is directed to the Citation of Prior art in Patents and Reexamination Proceedings. These proceedings are quite different than Ex Parte prosecution of pending applications. It is noted on the bottom of page 2 in the instant petition, that Petitioner has cited references to the Patent Owner. Once again, this is quite different than an applicant for a pending patent. While in a Reexamination proceeding it is required to give the Patent Owner references and information twice, there is no patent owner present in the instant proceedings.

Additionally, Petitioner refers to Section 706.02 of the MPEP which concerns foreign documents. This section merely requires the examiner to obtain a translation of the document. The section is silent as to when this must occur. In fact, Section 901.05(d) states in part:

901.05(d) [R-3] Translation

Examiners may consult the translators in the *>Translations< Branch of the Scientific and Technical Information Center (STIC) for oral assistance in translating foreign patents or literature that are possible references for an application being examined. Examiners may also request written translations of pertinent portions of references being considered for citation or already cited in applications. See MPEP § 901.06(a), STIC Services - Translations, and MPEP § 903.03, Availability of Foreign Patents.

Examiners may request written translations at any point in the examination process, at the discretion of the individual examiner, but are encouraged to use oral assistance and/or language reference resources as much as possible in the early phases of examination. (emphasis added)

This clearly allows for examiners to obtain written translations at any point in the examination process. Oral translations are encouraged due to the tremendous burden that would be placed upon the Translation branch if all foreign language documents that are used in prosecution were submitted for translation. Along those same lines, if Petitioner's position was correct that no foreign language document could properly be used in a rejection unless a translation was obtained, then current pendency in the office would grow to tremendously unacceptable levels. In the instant case, the examiner relied upon an English language abstract, a partial oral translation and the figures of the reference to support the position of the rejection. It is also noted that the French document in question was cited and submitted to the office so it is logical to assume that Applicants were at least somewhat familiar with the document in question. After the non-final office action was sent, applicants had the opportunity to respond to these positions but merely elected to argue that the examiner improperly rejected the claims over an abstract and that said abstract did not meet the claims. In this case, the arguments were not applicable because it was clear from the statement of rejection that the examiner was relying on the actual French document for the basis of the rejection, with the abstract cited to merely support in part his position that the reference met the claimed limitations.

The question of finality comes down to whether the examiner introduced a new ground of rejection in the final office action. In this case, the rejection did not change. The claims were rejected over the same statute and the same piece of prior art. As to whether a clear issue was developed, the examiner's position and reasoning did not change from one action to the next. He

relied upon the same teachings of the French document. The fact that a translation was obtained merely supports and confirms the position initially taken by the examiner. As to whether a clear issue has been established, the examiner's position did not change from the non-final office action to the final office action. The fact that Applicants did not argue the teachings of the French reference as set forth by the examiner in the non-final office action does not change the fact that the examiner has clearly established the position taken by the office.

Accordingly, the finality of the July 19, 2005 office action was proper and the petition is **DENIED.**

Applicant's time for response to the July 19, 2005 office action continues to run as set forth in the office action.



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